

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated January 21, 2009 (hereinafter Office Action) have been considered. Claims 1-30 and 35-44 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

**1. Claims 1, 2, 15, 16, 29 and 44 are rejected based on 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2002/0191017 by Sinclair et al. (hereinafter “Sinclair”).**

Applicant respectfully traverses the rejections, because Sinclair has not been shown to teach or suggest each of the claimed limitations. For example, Sinclair has not been shown to teach receiving captured speech of another user through a radio connection and reproducing the captured speech of the other user, as set forth in independent Claims 1, 15, 29, and 44. While the cited portions of Sinclair teach that a user may input voice commands to an IVRU system and receive voice data from the IVRU system, the received data relates to a virtual voice character in the game (paragraphs [0087]-[0088]) and not another user of the game. No teaching or suggestion has been identified in Sinclair that a user receives captured speech of another user of the game. Without a presentation of correspondence to each of the claimed limitations, the prior art rejections are improper.

In response, on page 2 of the Office Action the Examiner cites paragraphs 0030, 0035, 0036, 0100, 0103 of Sinclair to further support the contention that Sinclair allegedly “discloses receiving captured speech of another user through a radio connection and reproducing the captured speech of the other user.” However, in these cited portions, there is no express or inherent teaching of the capture of user-to-user speech accompanied with the processing of game data as is specifically set forth in independent Claims 1, 15, 29, and 44. In paragraph 0030, Sinclair describes “a prior art system wherein a user 100 of a mobile station 102 communicates with another mobile station user 104 and a fixed terminal voice user 106” using voice communications. However this is related to a prior art system that is neither expressly nor inherently described as using speech capture in association with gaming.

In paragraphs 0035-0036, Sinclair describes “interactive fiction games can enable a user 100 to interact with other users 104 and 106, with various data structures, and with intelligent software entities” such as via a “virtual space 312 [that] provides a mobile station user 100 with a perceptual awareness of other mobile station users 104, as in a telephone voice call.” This merely states that the virtual space provides a perceptual awareness similar to that experienced in a voice call. In view of the teachings of the Sinclair reference as a whole, this cannot be reasonably interpreted as stating that a user-to-user telephone voice call is used in the games described elsewhere in Sinclair. For example, none of the specific voice interactions with the IVRU in Sinclair (*e.g.*, 0085-0097) describe user-to-user communication of captured speech in conjunction with game play.

Paragraphs 0100 and 0103 of Sinclair, describe components of a mobile station “containing an audio interface, i.e. a speaker 1804 and microphone 1806.” However, nowhere do these paragraphs describe that captured speech of another user is transferred with game data over the same radio connection to/from a game terminal or game server.

The Federal Circuit recently held that “[b]ecause the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” (*Net Moneyin, Inc. v. Verisign, Inc.*, 2008 WL 4614511 (Fed. Cir. 2008)). Sinclair only makes reference to user-to-user voice communications in discussions of prior art communications systems, and not in conjunction with any type of gaming communications. In Sinclair’s gaming system, and the only voice content incorporated into game play is the automated IVRU, described *e.g.*, at 0085-0097. Thus Sinclair fails to describe all the elements of Claims 1, 15, 29, and 44 as arranged in the claims. Accordingly, the rejection of these Claims 1, 15, 29, and 44 is clearly erroneous, and Applicant respectfully requests that the rejection be withdrawn.

Dependent Claims 2 and 16 depend from independent Claims 1 and 15, respectively, and also stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sinclair. While Applicant does not acquiesce to the particular rejection to these dependent claims, the rejection is also improper for the reasons discussed above in connection with the

independent claims. These dependent claims include all of the limitations of their respective independent claims and any intervening claims, and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2 and 16 is improper, and each of these dependent claims is also patentable over the teachings of Sinclair. Applicant accordingly requests that the § 102(b) rejection be withdrawn.

**2. Claims 3-14, 17-28, 30, and 35-43 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Sinclair in view of U.S. Publication No. 2006/0165027 by Heden (hereinafter “Heden”).**

As discussed above, Sinclair fails to correspond to each of the limitations of independent Claims 1, 15, 29, and 44 and the further reliance on Heden does not overcome the above-discussed deficiencies in Sinclair. Similarly, the combination of Sinclair and Heden fails to teach or suggest transfer of speech and game data in a Dual Transfer Mode DTM radio connection to and from a wireless portable game terminal through the radio connection as set forth in independent Claim 30. Heden merely teaches that a mobile station’s capabilities be taken into account when negotiating quality of service for a service, not that a mobile station transfers both speech and game data using any of the identified connections, as claimed. The mere assertion that one of ordinary skill would have modified Sinclair to negotiate a quality of service as taught by Heden fails to provide correspondence to several of the limitations absent from the teachings of Sinclair. For example, modifying Sinclair to negotiate a quality of service does not provide for transferring speech and game data in Sinclair’s system using specific transfer protocols, but rather, it would merely involve taking into account a device’s capability to use such protocols when making a connection. Without correspondence to each of the claimed limitations, the § 103(a) rejection is also improper, and Applicant requests that the rejection be withdrawn.

Moreover, the assertion that a skilled artisan would look to the teachings of Heden to modify the system of Sinclair fails to articulate the requisite evidence to support the rejection and is based upon hindsight reasoning. First, the mere assertion that one would modify the teachings of Sinclair fails to provide any rationale or evidence for making the asserted modification. Second, Heden makes no mention of, and is unrelated to,

transferring speech and game data. A skilled artisan using common sense would not look to Heden's negotiation of quality of service to modify Sinclair's game service. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). Therefore, Applicant respectfully submits that the proffered motivation is a hindsight modification of prior art based on Applicant's teachings, and the requisite showing of motivation to modify Sinclair with the teachings of Heden has not been met. Applicant accordingly requests that the § 103(a) rejection be withdrawn.

Authorization is given to charge Deposit Account No. 50-3581 (NKO.031.A1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC  
8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700

Date: April 14, 2009

By: /William B. Ashley/

William B. Ashley  
Reg. No. 51,419